

REMARKS

Applicants acknowledge and thank the Examiner for withdrawn the prior art rejections of the prior Office Action.

Written Description Rejection

The pending claims 5-7 and 12- 14, which we not amended in the prior response, have now been rejected as allegedly violative of the written description requirement under 35 USC 112. Applicants believe a *prima facie* case of lack of written description has not been made out and therefore respectfully traverse this ground of rejection for the following reasons.

The Office Action states that the claims contain subject matter which was not described in the specification such that a person of skill in the art would know that the inventors were in possession of the invention as of the filing date of the application. The Action further states that there is no “per se structure/function relationship between the disclosed retinoid receptor agonists compounds and any other that may be found using the claimed method.”

However, the present claims are not drawn to methods of finding compounds, or to therapeutic methods relying on screening methods to identify a representative number of species of compounds to be used. Rather, what is claimed is a method of using retinoid receptor agonists for the treatment of various cartilage or bone pathologies.

Applicants note that the claim language (“retinoid receptor agonist”) to which this ground of rejection is directed has been present in the claims at issue since the application was filed, nor does the Office Action allege otherwise. Comment 3 of the *Final Examiner Guidelines on Written Description Requirement* (66 FED. REG. 1099 (2001)) indicate that in the case of language present in an originally filed claim “there is a strong presumption that an adequate description is present when the application is filed” and “in most cases the statement that ‘an originally filed claim is its own written description’ is borne out, because the claim language conveys to others of skill in the art that the applicant was ‘in possession’ of what is claimed”. *Id.* at 1100. (emphasis added). Further, “the examiner has the initial burden . . . of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims: *Id.* at 1105.

Applicants submit that the Office Action failed to set forth sufficient reasoning to overcome the strong presumption of compliance with the written description requirement. Moreover, even if it had, the present application

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itself contains abundant evidence to rebut a *prima facie* holding to the contrary. To this end, Applicants point out that on page 21 the disclosure of the present application contains, as incorporated by reference, the disclosure of 33 patents that disclose the structures of literally millions of retinoid receptor agonists. Furthermore, the term "retinoid receptor agonist", particularly in light of the specification, is a well known phrase to those of skill in the art. A cursory search of the term "retinoid receptor agonist" conducted by the undersigned using the PubMed abstract database reveals 147 hits representing publications having a publication date of 1999 or earlier and containing these terms in their abstracts alone. Thus, clearly the skilled worker was abundantly familiar with this term at the priority date of the present application.

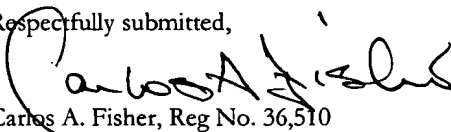
Given these facts, Applicants respectfully maintain that there is no precedent in the case law or the Guidelines for the holding that the present claims violate the written description requirement, and ask the Examiner to reconsider and withdraw this ground of rejection.

Lack of Antecedent Basis

The currently pending Office Action also rejected claim 6 under 35 USC 112, second paragraph as reciting a "retinoid receptor antagonist". This was a typographical error; claim 6 has now been amended to recite a "retinoid receptor agonist".

For these reasons the Applicants respectfully request reconsideration and withdrawal of this rejection. Please use Deposit Account 01-0885 for the payment of the extension fee and any other fee due.

Respectfully submitted,



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